

ESTTA Tracking number: **ESTTA648242**

Filing date: **01/05/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054171
Party	Plaintiff Valeritas, Inc.
Correspondence Address	SHERI S MASON MORSE BARNES-BROWN & PENDLETON 230 3RD AVE FL 4 WALTHAM, MA 02451 UNITED STATES smason@mbbp.com, ttab@mbbp.com, tdunn@mbbp.com, scon- nolly@mbbp.com, gkrakau@mbbp.com
Submission	Reply in Support of Motion
Filer's Name	Thomas F. Dunn
Filer's e-mail	ttab@mbbp.com, Barbara.Barakat@wilmerhale.com, an- gela.dyer@wilmerhale.com, Michael.Bevilaqua@wilmerhale.com
Signature	/Thomas F. Dunn/
Date	01/05/2015
Attachments	Reply Brief to Response to MSJ (Proceeding No 92054171) (M0719735).PDF(990692 bytes )

Valeritas, Inc.,	)	In the matter of:	U.S. Reg. No. 3,895,432
	)		
Petitioner,	)	For the Mark:	VGO
	)		
v.	)	Filing Date:	March 2, 2010
	)		
VGo Communications, Inc.	)	Registration Date:	December 21, 2010
	)		
Respondent.	)	Cancellation No.:	92054171
	)		

While Petitioner appreciates that the filing of reply briefs is discouraged, Petitioner respectfully requests the Board to consider this reply given that new evidence has come to light.

1

When the marks at issue are both design marks, the similarity of the marks must be decided primarily on the basis of visual similarity. ... In this situation, consideration must be given to the fact that the marks usually will not be viewed side-by-side in the marketplace and a purchaser's recollection of design marks is often of a general, rather than specific, nature; thus the marks may be confusingly similar despite differences between them.

(T.M.E.P. 1207.01(c) Design Marks.) (Citations omitted.)

The fact that Petitioner's mark includes "Disposable Insulin Delivery" in small print whereas Respondent's does not, and the fact that Respondent's mark includes a wheel symbol with trailed by two pointed lines whereas Petitioner's mark includes a design element comprised of a circular point with a line trailing behind it, both ignore the obvious: Respondent simply started with Petitioner's literal mark VGO, moved Petitioner's design element to the position where the small print appears, and modified the design element slightly. In other words, the dominant components of both marks are (i) the literal VGO element, and (ii) the horizontal design element comprised of a circular element on the right with linear trailing elements to the left. Other differences of the type described by Petitioner, such as the slight difference in font size, are so minor as to be irrelevant. I.e., a purchaser's recollection of these two design marks is likely to be general, rather than specific, nature and, therefore, confusion as between these two marks is likely. *Id.*

Second, while Respondent goes at great length to argue that confusion is unlikely because Petitioner provides insulin delivery devices whereas Respondent provides telepresence devices ignores the fact that the two devices are complementary.

#### 1207.01(a) Relatedness of the Goods or Services

In assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks of the respective parties are identical or virtually identical, the relationship between the goods and/or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *Shell Oil*, 992 F.2d at 1207, 26 USPQ2d at 1689; *In re Davey Prods. Pty Ltd.*, 92 USPQ2d

1198, 1202 (TTAB 2009); In re Thor Tech, Inc., 90 USPQ2d 1634, 1636 (TTAB 2009).

T.M.E.P. 1207.01(a) Relatedness of the Goods or Services).

Petitioner has never argued the products are closely related because they are similar, but rather has argued the products are closely related because they are complementary. And it is this regard that the recently-obtained evidence from Respondent is relevant. See Exhibit A.<sup>1</sup> Petitioner is unable to quote the email exchange at Exhibit A here given the designation as confidential, but suffice to say the exchange describes in detail how one may use the robot to aid in the management and treatment of diabetes, specifically, in the management of blood sugar readings and diet by means of a direct exchange between a diabetic patient and a healthcare provider. While Respondent argues that “It is difficult to believe that anyone would think that a remote communication robot would deliver a continuous supply of insulin over a 24-hour period or that such a robot and an insulin delivery device would be provided by the same source,” the evidence plainly demonstrates that the two products are complementary and likely to be used together. A video evidencing how the products may be viewed here: <http://www.myfoxtampabay.com/story/18048844/health-care-tools-of-the-future>.<sup>2</sup> Petitioner’s further arguments that confusion is unlikely because its product is not used solely in the healthcare field but is also used in such fields as education, manufacturing, etc. is as unavailing

---

<sup>1</sup> Petitioner has redacted the evidence at Exhibit A because the documents were marked “For Attorney’s Eyes Only.” Petitioner has redacted the evidence nearly in the entirety because, although designated confidential, it is not clear precisely what (if indeed anything) is confidential. Petitioner has submitted this evidence separately under seal, as provided by the rules. Petitioner notes, too, that in its response Respondent attached documents with Petitioner had designated confidential. I.e., while Petitioner is making every effort to keep confidential materials under seal, Respondent has failed to do so.

<sup>2</sup> Petitioner was unable to obtain a digital copy of this video by subpoena within the time allowed for this reply. The URL to the video was not known to the Petitioner until it reviewed the documents produced by Respondent during Petitioner’s Testimony Period. Accordingly, Petitioner respectfully requests that the Board take judicial notice of this publicly available video and consider it when deciding this matter.

as the argument that confusion is unlikely because the size of the robot is greater than the size of the insulin delivery device.

Next, Respondent's arguments concerning target markets and channels of trade are misplaced. While it is the case that Petitioner's product requires FDA approval and is prescribed by a physician, it is also the case, as Respondent admits in its Response at p. 11, that that it "advertises to individual healthcare providers, *e.g.*, individual physicians ...." Reliance on Astra is readily distinguishable here, given that the literal components of the two marks are identical and the design elements are likewise identical in every major respect. Moreover, it is well-settled that even sophisticated purchasers are not immune to trademark confusion:

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune to source confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (indicating that "even sophisticated purchasers can be confused by very similar marks"); *Top Tobacco, LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011); *In re Total Quality Grp., Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983); cf. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, \_\_\_ F.3d \_\_\_, 110 USPQ2d 1157, 1163 (Fed. Cir. Mar. 26, 2014) (affirming that TTAB properly considered all potential investors for recited services, which included sophisticated investors, but that precedent requires TTAB decision to be based "on the least sophisticated potential purchasers.") ....

#### T.M.E.P. 1207.01(d)(vii) Sophisticated Purchasers

This is particularly the case given the evidence of actual confusion in the case of Dr. Whatley. While "it is unnecessary to show actual confusion to establish likelihood of confusion," (T.M.E.P. 1207.01(d)(ii) Absence of Actual Confusion)(citing cases), the Board has often noted that "[i]n general, evidence of actual confusion is notoriously difficult to come by." *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1604 (TTAB 2011). Indeed, the Federal Circuit has said that "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion." *Majestic Distilling Co.*, 65 USPQ2d at 1205.

Accordingly, the Board should find that the factor of actual confusion favors a finding of likelihood of confusion.

Finally, notwithstanding Respondent's protestations to the contrary, it is not necessary to walk through every DuPont factor exhaustively in order to decide a case on summary judgment:

A fact is material if it "may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings." However, a dispute over a fact that would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. TBMP 528.01 citing, Kellogg Co. v. Pack'Em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (single du Pont factor of dissimilarity of marks outweighed all others such that other factors, even if decided in nonmovant's favor, would not be material because they would not change the result), aff'd 14 USPQ2d 1545 (TTAB 1990). See also Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986); Institut National Des Appellations d'Origine v. Brown-Forman Corp., 47 USPQ2d 1875, 1879 (TTAB 1998).

Based on the foregoing, Petitioner respectfully requests the Board grant Petitioner's Motion for Summary Judgment.

January 5, 2015

Respectfully Submitted,

VALERITAS, INC.

By: /Thomas F. Dunn/  
Thomas F. Dunn  
Morse, Barnes-Brown & Pendleton, P.C.  
CityPoint  
230 Third Avenue, 4<sup>th</sup> Floor  
Waltham, Massachusetts 02451  
Tel: 781.622.5930  
Fax: 781.622.5933  
Email: [ttab@mbbp.com](mailto:ttab@mbbp.com)

## **CERTIFICATE OF SERVICE**

I, Tracy D. Skahan, certify that a copy of the foregoing EVIDENTIARY SUBMISSION OF CONFIDENTIAL MATERIAL OBTAINED IN DISCOVERY was served on:

Michael J. Bevilacqua, Esq.  
Barbara A. Barakat, Esq.  
Wilmer Cutler Pickering Hale & Dorr LLP  
60 State Street  
Boston, Massachusetts 02109

by placing same with the U.S. Postal Service, via first class mail, postage pre-paid, this 5th day of January, 2015.

/Tracy D. Skahan/  
Tracy D. Skahan

## **Exhibit A**



[REDACTED]

From: [REDACTED]  
Sent: [REDACTED]  
To: [REDACTED]  
Cc: [REDACTED]  
Subject: [REDACTED]  
Attachments: [REDACTED]

[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]  
[REDACTED]

[REDACTED]

CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

[REDACTED]

From: [REDACTED]  
Sent: [REDACTED]  
To: [REDACTED]  
Cc: [REDACTED]  
Subject: RE: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]

[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

From: [REDACTED]  
Sent: [REDACTED]  
To: [REDACTED]  
Cc: [REDACTED]  
Subject: RE: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

[REDACTED]  
[REDACTED]

[REDACTED]

From: [REDACTED]  
Sent: [REDACTED]  
To: [REDACTED]  
Cc: [REDACTED]  
Subject: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]  
[REDACTED] [REDACTED] [REDACTED]  
[REDACTED] [REDACTED] [REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]

[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

[REDACTED]

CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

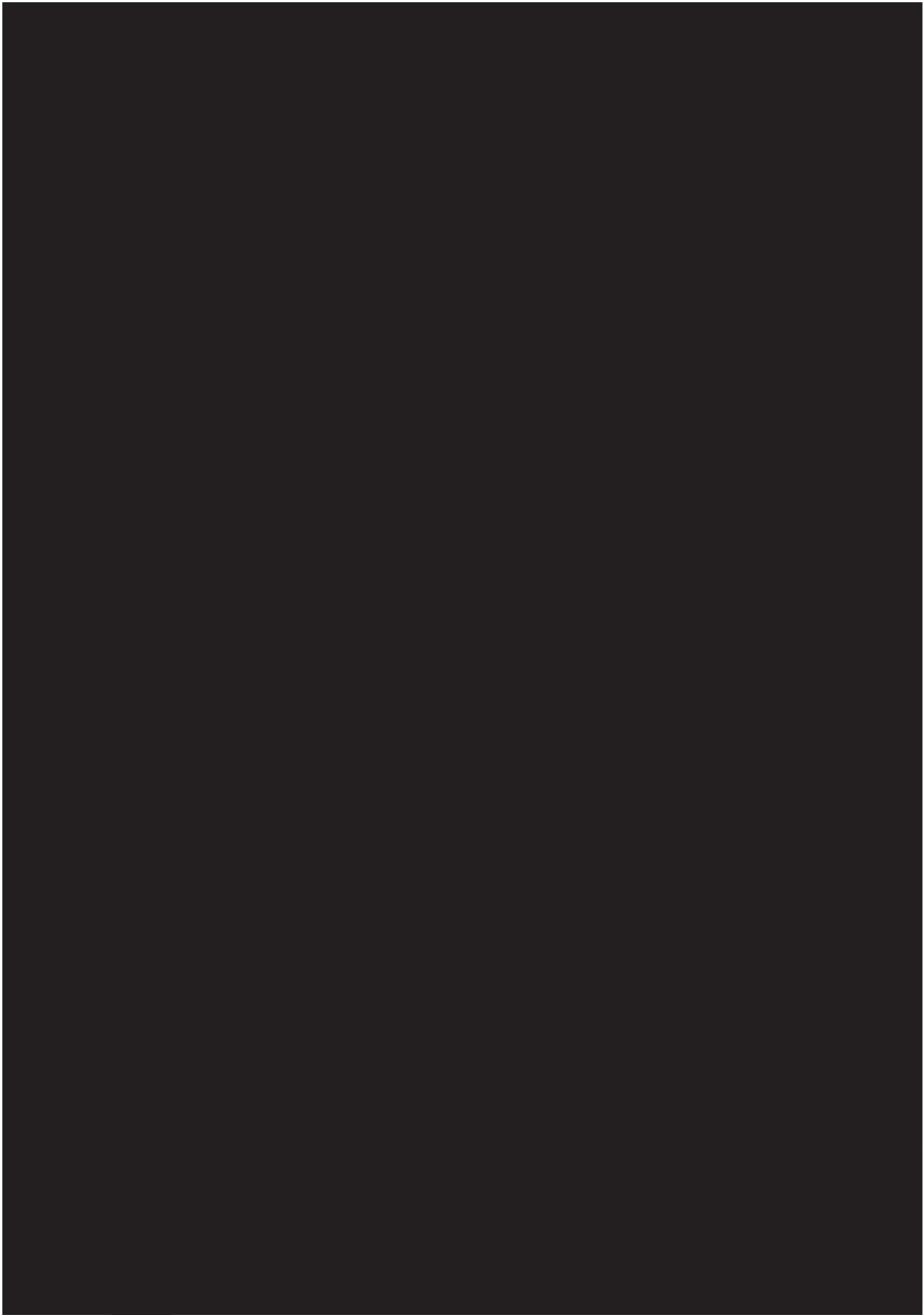
CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

VGO 001577



CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

VGO 001578



CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

VGO 001579



CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

VGO 001580



CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY

VGO 001581

[REDACTED]

From: [REDACTED]  
Sent: [REDACTED]  
To: [REDACTED]  
Subject: [REDACTED]

[REDACTED]

From: [REDACTED]  
Sent: [REDACTED]  
To: [REDACTED]  
Cc: [REDACTED]  
Subject: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

CONFIDENTIAL -  
FOR ATTORNEYS'  
EYES ONLY